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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,338	03/01/2002	John p. Ruckart	010417	4121

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EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2645

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/086,338

Applicant(s)

RUCKART, JOHN P.

Examiner

Lisa Hashem

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **FINAL DETAILED ACTION**

### ***Claim Objections***

1. Claims 6 and 14 are objected to because of the following informalities: Claims 6 and 14 recite the limitation "the group". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US Patent No. 6,393,272 by Cannon et al, hereinafter Cannon.

Regarding claim 1, Cannon discloses a telecommunications device, comprising: a receiver for receiving an incoming call (Figure 1, 113); and a processor in communication with the receiver (Figure 1, 109), the processor having a call hold module or Answer & Hold input element (Figure 1, 121), the call hold module for determining whether to place the call on hold prior to the call being answered by a user of the telecommunications device (column 2, lines 12-29) based on a schedule received from the user of the telecommunications device, the schedule including at least one time period during which the incoming call is placed on hold (column 3, line 46 – column 4, line 2; column 4, lines 44-51).

Art Unit: 2645

Regarding claim 2, the device of claim 1 mentioned above, wherein Cannon further discloses the device is selected from the group consisting of a wireless telephone and a wireline telephone (column 2, lines 12-19).

Regarding claim 3, the device of claim 1 mentioned above, wherein Cannon further discloses the receiver includes an RF transceiver unit (Figure 1, 113; column 2, lines 18-19).

Regarding claim 4, the device of claim 1 mentioned above, wherein Cannon further discloses the processor includes a digital signal processor (column 2, lines 17-18).

Regarding claim 5, the device of claim 1 mentioned above, wherein Cannon further discloses the processor includes a microcontroller (column 2, lines 17-18).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,393,272 by Cannon in view of US Patent No. 6,668,049 by Koch et al, hereinafter Koch.

Regarding claim 6, Cannon discloses a method of placing an incoming call to a telecommunications device from a calling party on hold prior to being answered by a called party, the method comprising: receiving one or more parameters of a hold function via a web interface, wherein the parameters are selected from a group consisting of at least a schedule including at least one time period during which the incoming call is

Art Unit: 2645

placed on hold, and a list including at least one potential calling party from whom incoming calls are placed on hold (column 3, line 46 – column 4, line 2; column 4, lines 44-51): automatically answering the call if the call corresponds to the one or more parameters of the hold function; playing a message to the calling party; and connecting the called party to the calling party when the called party answers the call.

Cannon does not disclose receiving one or more parameters of a hold function via a web interface.

Koch discloses a method of placing an incoming call to a telecommunications device from a calling party on hold prior to being answered by a called party (see Abstract), the method comprising: receiving one or more parameters of a hold function via a web interface, wherein the parameters are selected from a group consisting of at least a list including at least one potential calling party from whom incoming calls are placed on hold; automatically answering the call if the call corresponds to the one or more parameters of the hold function; playing a message to the calling party; and connecting the called party to the calling party when the called party answers the call (see Figure 6B; column 10, line 47 – column 11, line 37).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Cannon such that it includes a web interface as taught by Koch. One of ordinary skill in the art would have been lead to make such a modification since the hold function may be enabled and the parameters defined via a web interface.

Art Unit: 2645

Regarding claim 7, the method of claim 6 mentioned above, wherein Cannon further discloses determining whether the called party has enabled a hold function (column 2, lines 30-43).

Regarding claim 8, the method of claim 6 mentioned above, wherein Cannon further discloses determining whether the called party has pressed a button or Answer & Hold key on the telecommunications device to enable a hold function (column 2, lines 30-43).

Regarding claim 9, the method of claim 6 mentioned above, wherein Cannon further discloses alerting the called party of the incoming call (column 2, lines 33-35).

Regarding claim 10, the method of claim 6 mentioned above, wherein Cannon further discloses inherently connecting the calling party to a voicemail system when the called party does not answer the call within a predetermined time period (column 3, lines 46-51).

Regarding claim 11, the method of claim 6 mentioned above, wherein Cannon further discloses playing a message to the calling party includes playing a message that is resident on a services node of a telecommunications network (column 5, lines 14-52).

Regarding claim 12, the method of claim 6 mentioned above, wherein Cannon further discloses playing a message to the calling party includes playing a pre-recorded message stored in a memory device resident on the telecommunications device (column 2, lines 38-43; column 4, lines 11-14; column 4, lines 60-64).

Regarding claim 13, the method of claim 6 mentioned above, wherein Cannon further discloses connecting the call to a voicemail system when the called party presses a button on the telecommunications device (column 3, lines 34-45).

Art Unit: 2645

Regarding claims 17-20, please see the rejections of the method in claims 6-9 mentioned above, respectively, to reject the apparatus in claims 17-20.

6. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,668,049 by Koch in view of US Patent Application Publication No. 2003/0134662 by Shah et al, hereinafter Shah.

Regarding claim 14, Koch discloses a telecommunications system (see Abstract), comprising: a database or SCP for storing a profile of a user of a telecommunications device, wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system (column 4, lines 19-37); a services node or application server for: determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service: placing the incoming call on hold prior to the call being answered; playing a message to the calling party; and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call: and a communications center for facilitating communication between the telecommunications device, the services node, and the home location register (see Figure 6B; column 10, line 47 – column 11, line 37).

Koch does not disclose a home location register and a mobile switching center.

Shah discloses a wireless communications system inherently comprising: a home location register for inherently storing a profile of a user of a telecommunications device, wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service or call waiting service implemented by the

Art Unit: 2645

telecommunications system (see Abstract; section 0002, line 1- section 0004, line 16); a base station for: determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service: placing the incoming call on hold prior to the call being answered; playing a message to the calling party; and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call: and a mobile switching center for facilitating communication between the telecommunications device, the services node, and the home location register (section 0020, lines 1-14).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Koch such that it includes a MSC and its components as taught by Shah. One of ordinary skill in the art would have been lead to make such a modification since the hold function may be implemented in a mobile communications system that inherently includes a home location register and a mobile switching center.

Regarding claim 15, the system of claim 14 mentioned above, wherein Koch further discloses the services node includes an enunciator (column 10, lines 47-59).

Regarding claim 16, the system of claim 15 mentioned above, wherein Koch further discloses the enunciator is for playing a message to a calling party when a call is placed on hold (column 10, lines 47-59).

### ***Response to Arguments***

7. In response to the Amendment filed on June 30, 2004, Applicant argues that Cannon fails to disclose in claim 1: "determining whether to place the call on hold prior



Art Unit: 2645

to the call being answered by a user of the telecommunications device based on a schedule received from the user of the telecommunications device, the schedule including at least one time period during which the incoming call is placed on hold". The Examiner disagrees with the Applicant. These limitations were not cited in the original claims submitted on March 1, 2002. Cannon clearly discloses the user determines a time period when the incoming call is placed on hold, e.g. while the user is in a meeting, wherein please reference: column 3, line 46 – column 4, line 2; column 4, lines 44-51.

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2645

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302.


The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general  
nature or relating to the status of this application or proceeding should be directed to the  
Group receptionist whose telephone number is (703) 305-3900.

LH

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October 18, 2004

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600